



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,873	06/14/2001	Kulvir S. Bhogal	AUS920010390US1	8232
43307	7590	08/11/2009		
IBM CORP (AP) C/O AMY PATTILLO P. O. BOX 161327 AUSTIN, TX 78716			EXAMINER ZEWDU, MELESS NMN	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 08/11/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/881,873	Applicant(s) BHO GAL ET AL.	
	Examiner Meless N. Zewdu	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1032 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the communication filed on 5/12/09.
2. Claims 1-32 are pending in this action.

Claim Rejections - 35 USC § 112

Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this regard one of ordinary skill in the art would not understand how to --- **determining a call count based on time increment and modifying the call count, (for instance, as recited in claim 1)** --- without having more than one calls, which is not provided in the specification in a manner as being claimed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2617

Claim 1-32 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The invention defined by the claimed methods, means, and system does not perform the recited features, for instance as recited in claim 1, --- determining a call count based on time increments; and modifying the call count based on calling plan parameters. It may count only time in response to a received call; but, it is not operational to count calls and thus cannot modify a call count, as there is no more than one call supported by the claims. Furthermore, the claimed system and/or method is not capable of “subtracting the modified call count from a time ratio” as recited in claims 3 and 18 and further is not capable of “rounding the call” as recited in claims 4 and 19, since there is no more than one call (since there is only one call) to begin with. In other words, subtraction or modification, within the context of the claims 3, 4, 18 and 19, requires a given quantity of calls, which is absent from these claims, thereby making the claims inoperable. For examination purposes, claims 1-32 are considered as calling for --- counting, summing and modifying a call time as a function of a call.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See

Art Unit: 2617

MPEP § 2172.01. The omitted structural cooperative relationships are: calls that are more than one in number (for instance, call number 1, call number 2, etc.), which are to be counted and modified by the claimed controller within the claimed phone unit. As indicated, for instance, in claim 1, the features, -- determining a call count based on time increments; and modifying the call count based on calling plan parameters, requires the presence of more than one call to be counted as a function of time.

Claims 3 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case “subtracting the modified call count from a time ratio” since the unit of call and time are different the two quantities can not be subtracted from each other. For examination purposes, claims 1-32 are considered as calling for --- counting, summing and modifying a call time as a function of a call.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 6, 16, 17, 21 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Tysor (US 2002/0151293 A1

As per claim 1: Tysor discloses a method of tracking communications usage time by a controller within a phone unit during a call (see paragraphs 0011-0012, 0043, comprising:

counting time increments (tracking minutes) in response to a call (see paragraphs 0009-0010, 0043);

determining a call count based on time increments (see paragraphs 0008-0010, 0043); and

modifying the call count based on calling plan parameters (see paragraphs 0027, 0047-0048). Adding Air Time (as in paragraph 0027) or deducting from the available minutes (as in paragraphs 0047- 0048) can be considered as modifying a call count.

As per claim 2: Tysor discloses a method of summing the modified call count with at least one other call count from at least one other call (see paragraphs 0008-0010, 0043);

determining an accumulated call count from the summing (see paragraphs 0047-0008-0011, 0047).

As per claim 3: Tysor discloses a method further comprising: subtracting the modified call count from a time ratio and determining a remaining call count from the subtracting (see paragraph 0048).

Art Unit: 2617

As per claim 4: Tysor discloses about a method wherein modifying the clal count comprises rounding the call count to a nearest whole minute based on a setting in the calling plan parameters to round the next whole minute (see paragraphs 0034, 0042).

As per claim 16: the features of claim 16 are similar to the features of claim 1, except claim 16 is directed to a computer readable medium intended to perform the steps of claim 1. However, the prior art discloses the steps of claim 1, as discussed therein. Hence, the computer readable medium must be an inherent feature in the prior art communication system.

As per claim 17: the features of claim 17 are similar to the features of claim 2. Hence, claim 17 is rejected on the same ground as claim 2 and including the explanation provided regarding the rejection of claim 16.

As per claim 18: the feature of claim 18 is similar to the feature of claim 3. Hence, claim 18 is rejected on the same ground as claim 3.

As per claim 19: the features of claim 19 are similar to the features of claim 4. Hence, claim 19 is rejected on the same ground as claim 3.

As per claim 31: the features of claim 31 are similar to the features of claim 1, except claim 31 is directed to a system comprising means to perform the functions/steps of claim 1. However, the prior art discloses the steps of claim 1, as discussed therein. Hence, a system/means that performs the steps of claim 1 must be an inherent feature within the embodiment of the prior art.

As per claim 32: the features of claim 32 are similar to the features of claim 1, except --
- storing the modified call count I the memory of the cellular telephone unit, which is also

Art Unit: 2617

disclosed by Tysor (see 0011, 0033, 0043; claims 3 and 11). Note: the process includes adding and subtracting used time from available time (this modifying) (as provided in paragraphs 0047-0048) and includes calls for different calling periods according to a calling plan and further including storing the record. Thus, claim 32 is rejected on the same ground as claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8, 21-23 and 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tysor in view NEC CORP reference, (JP 07066909 A).

As per claim 6: Tysor discloses a method, wherein modifying the call count comprises based on a calling plan parameters comprises reducing (subtracting) the call count proportional to a pre-determined calling plan parameters (see paragraphs 0011, 0043).

But, Tysor does not explicitly teach about a call count based on a pre-determined discount for discounting an incoming call (incoming call time). However, in the same field of endeavor, the NEC abstract teaches about a telephone set comprising a counter for recording the calls performed and an adder for accumulating/storing the calls counted during a discounted tariff time period based on the output of a clock (see abstract). It is to be noted that the accumulated call count can be considered as a

Art Unit: 2617

modified call count since the accumulated call count is not the same as the initial call count. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Tysor with that of Toda for the advantage of a subscriber to optimize utilization of discount tariff during a specified time period.

As per claim 7: the feature of claim 7 is similar to the feature of claim 6 except a night time call within cutoff times for weekend days, which is taught by Tysor (see paragraphs 0033-0034, 0043) Toda teaches a method, wherein modifying the call count comprises discounting a night time call (see title; abstract). Therefore, claim 7 is rejected on the same ground and motivation as claim 6.

As per claim 8: the NEC reference teaches a method, wherein modifying the call count comprises discounting a weekend call (see title; abstract). Toda's reference teaches about a discounted tariff time period, which could include any discounted time period designated for such purpose, including a weekend call discount time period.

As per claim 21: the feature of claim 21 is similar to the feature of claim 6. Hence, claim 21 is rejected on the same ground as claim 6, including the explanation provided regarding the rejection of claim 16.

As per claim 22: the feature of claim 22 is similar to the feature of claim 7. Hence, claim 22 is rejected on the same ground and motivation as claim 7 and further including the explanation provided regarding the rejection of claim 16.

Art Unit: 2617

As per claim 23: the feature of claim 22 is similar to the feature of claim 8. Hence, claim 23 is rejected on the same ground and motivation as claim 8 and further including the explanation provided regarding the rejection of claim 16.

Claims 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tysor, as applied to claims 1 and 16 above, and further in view of Kraushaar et al. (Kraushaar) (US 4, 200,771).

As per claim 5: but, Tysor, as applied to claims 1 and 16 above, does not explicitly teach about a method of subtracting an initial connection time from a call count, as claimed by applicant. However, in the same field of endeavor, Kraushaar teaches about “traffic measuring device based on state transaction” wherein a call time monitor/time counter is provided to monitor current time which is either to be added to or subtracted from an accumulated total call duration (see col. 5, 3-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Tysor with that of Kraushaar for the advantage of providing more accuracy in counting calls (see abstract, lines 1-7).

As per claim 20: the feature of claim 20 is similar to the feature of claim 5. Hence, claim 20 is rejected on the same ground and motivation as claim 5.

Claims 9-13 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tysor, as applied to claims 1 and 16 above, and further in view of Spitaletta et al. (Spitaletta) (US 6,112,077).

As per claim 9: while Tysor discloses the features of claims 1 and 16, including a modified call count, He fails to explicitly teach about a method of – providing a special

Art Unit: 2617

usage parameter (rate) and calculating a special call count based on the special usage parameter (rate), as claimed. However, in the same field of endeavor, Spitaletta teaches about a non-reusable cellular telephone, wherein the cellular telephone is provided with a means to account for the cost difference of calls made to different calling areas, including calls within one area code (local) and long distance calls by deducting time at different rate (see col. 4, lines 19-34). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Tysor with that of Spitaletta for the advantage of enabling the cellular telephone to store a plurality of rate factors corresponding to area codes and dialing prefixes of possible phone numbers for calculating the remaining time of the calling time (see col. 2, lines 27-30).

As per claim 10: Spitaletta teaches about a method, wherein the special usage parameter comprises a long distance parameter (rate), and the special call count comprises a long distance usage count (see col. 4, lines 19-34).

As per claim 11: Spitaletta teaches about a method, wherein the special usage (rate) comprises a local distance parameter (rate), and the special call count comprises a local distance usage count (see col. 4, lines 19-34).

As per claim 12: the feature of claim 12 is similar to the feature of claim 7, with the exception that the call in claim 12 recites '**special usage parameter**', which reads on Toda's "calls counted during a discount tariff time" (see Toda's abstract). Hence, claim 12 is rejected on the same ground and motivation as claim 7.

Art Unit: 2617

As per claim 13: the feature of claim 13 is similar to the feature of claim 8, with the exception of claim 13 recites '**special usage parameter**'. Toda's "calls counted during a discount tariff time" could be read as a call comprising a special usage parameter, wherein discount tariff time is the parameter. Hence, claim 13 is rejected on the same ground and motivation as claim 8.

As per claim 24: the features of claim 24 are similar to the features of claim 9. Hence, claim 24 is rejected on the same ground and motivation as claim 9 and further including the explanation provided with regard to the rejection of claim 16.

As per claim 25: the feature of claim 25 is similar to the feature of claim 10. Hence, claim 25 is rejected on the same ground and motivation as claim 10 and further including the explanation provided with regard to the rejection of claim 16.

As per claim 26: the feature of claim 26 is similar to the feature of claim 11. Hence, claim 26 is rejected on the same ground and motivation as claim 11 and further including the explanation provided with regard to the rejection of claim 16.

As per claim 27: the feature of claim 27 is similar to the feature of claim 7, with the exception that the call in claim 27 recites '**special usage parameter**'. In Toda, "calls counted during a discount tariff time" is similar to a special usage parameter, wherein time is the parameter. Hence, claim 27 is rejected on the same ground and motivation as claim 7.

As per claim 28: the feature of claim 28 is similar to the feature of claim 8, with the exception, that claim 28 recites '**special usage parameter**'. In Toda, "calls counted

Art Unit: 2617

during a discount tariff time” is similar to a special usage parameter, wherein time is the parameter. Hence, claim 28 is rejected on the same ground and motivation as claim 8.

Claims 14-15 and 29 -30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tysor in view of Spitaletta, as applied to claims 1, 9, 16 and 24 above, and further in view of Brown (US 5,987,107).

As per claim 14: but, Tysor in view of Spitaletta does not explicitly teach about a method, wherein the special usage parameter comprises a peak usage parameter, and the special call count comprises a peak usage count, as claimed by applicant. However, in the same field of endeavor, Brown teaches about charging for usage of a telecommunications network, wherein calls are defined by type, each call being identified based on the call type and calculating and accumulating charges (see col. 2, lines 10-37; col. 5, lines 41-56), utilizing discount schemes. Note: call type, in the context of Brown’s reference is considered to include peak type call. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify Tysor in view of Spitaletta with the teaching of Brown for the advantage of encouraging increased use of a network during off-peak periods (see col. 2, lines 10-22).

As per claim 15: Brown teaches a method, wherein the special usage parameter comprises an off-peak usage parameter, and the special call count comprises an off-peak usage count (see col. 2, lines 10-37; col. 5, lines 41-56). Brown also provides motivation as a marketing tool for “---providing discounts for particular types of calls” (see col. 2, lines 10-11).

Art Unit: 2617

As per claim 29: the feature of claim 29 is similar to the feature of claim 14. Hence, claim 29 is rejected on the same ground and motivation as claim 14.

As per claim 30: the feature of claim 30 is similar to the feature of claim 15. Hence, claim 30 is rejected on the same ground and motivation as claim 15.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bost Dwayne D can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2617

Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

/Meless N Zewdu/
Primary Examiner, Art Unit 2617
8/10/2009